

REMARKS

This letter is in response to the Examiner's Action dated 16 March 2006. Applicant has amended claim 18 to indicate that the composition contains a sodium or potassium salt. Support for the amendment is found in the original claims and in the specification at page 9, lines 8-22 of the application as filed. No new matter is inserted by way of amendment.

Before discussing the Examiner's position, Applicant points out that the invention relates to a water-soluble contact lens blocking composition. Blocking adhesives are used to securely mount a contact lens on a mandrel for mechanical machining of the lens surface to obtain the optical correction. Once the optical surfaces are machined on the lens, the lens is removed from the mandrel by dissolving the adhesive. Prior art adhesives were soluble in strong organic solvents such as trichloroethane. The rate of solubility of known prior art water-soluble adhesives was not sufficiently rapid for commercial productivity and required improvement. Applicant has found that the inclusion of an amount of a highly soluble sodium or potassium salt substantially increases the rate of dissolution of the polymer materials. Relatively insoluble materials, such as Calcium Carbonate, TiO₂, Alumina, Carbon, etc., can be harmful to the optical surfaces. Further such insoluble materials would not provide any increased solubility to the blocking compound (see page 9, lines 19-22).

The Examiner has rejected claims 18-22 under 35 U.S. C. § 102(b). The Examiner should note Applicant has amended claim 18 to recite that the composition contains a highly soluble sodium or potassium salt. The reference teaches conventional organic extenders, non-blocking antioxidants, inorganic fillers, dyes, colorants, etc. As the Examiner notes below, such fillers include calcium carbonate, zinc oxide, alumina, clay, titanium dioxide, talc, carbon black, etc. All of these materials are substantially water insoluble. Calcium carbonate is characterized by the Merck index (see the attached Merck Index Abstract) as "Practically insoluble in water." Such a material cannot be characterized as highly soluble. Further, such calcium carbonate salts are so insoluble that they would reduce the solubility of the adhesives, not enhance solubility of the adhesives. Accordingly, claims 18-22, are not anticipated by this reference.

The Examiner has further rejected claims 1-17 under 35 U.S.C. § 103 over a combination of Bunnelle et al., U.S. Patent No. 5,459,184 and Mackeen, U.S. Patent No. 5,595,764. Applicant respectfully traverses the rejection.

As discussed above, the primary reference does not teach the invention, since the invention requires a highly soluble sodium or potassium salt. Further, to establish a *prima facie* case of obviousness, three basic criteria must be met:

- (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings without hindsight to the claimed invention.
- (2) There must be a reasonable expectation of success.
- (3) The prior art references must teach or suggest all the claim limitations.

See In re Vaeck, 20 USPQ.2d 1438 (Fed. Cir. 1991); MPEP § 2143 et seq.

The Examiner's combination of the Bunnelle et al. reference and the Mackeen reference does not raise a *prima facie* case of obviousness.

First, all of the elements are not shown in the reference. There is no teaching in the Mackeen reference (or the Bunnelle et al. reference) of a highly soluble sodium or potassium salt. The Mackeen reference does teach a very sparingly soluble to practically insoluble calcium carbonate salt. Such a material would not provide the rate of solubility required in these contact lens blocking compounds to obtain more rapid solubility of the composition.

There is no motivation to combine these references. It is impossible to argue that the Mackeen reference can be combined with the Bunnelle et al. reference. The Mackeen reference teaches a medical treatment. The dry eye treatment uses a finely divided calcium carbonate material combined with ophthalmic materials such as glycerol to form a material useful for treating an ophthalmic dry eye syndrome. There is no suggestion in this reference that the materials of the reference can be combined with a water soluble polymer or used in a hot melt composition of any kind. The fact that when treating a patient, some of the composition may come in contact with the contact lens is irrelevant since the composition of Mackeen is so different than the hot melt-blocking compound of the claims. Inherency arguments have no place in rejections under 35 U.S.C. § 103.

Applicant has demonstrated the allowability of all claims 1-27 since the prior art does not teach the highly soluble salt of the claims to obtain a rapidly soluble contact lens blocking adhesive material. Other claims are allowable for additional reasons. Claim 1 is allowable since it recites a sodium or potassium salt having a particle size of less than 150 microns. This particle

size is not taught for the sodium or potassium salts. Claims 2, 6, 14, 25 all teach a particle size that is useful for obtaining the highly soluble contact lens property. Such a particle size would not render calcium carbonates sufficiently soluble to obtain the solubility properties desired. Claims 7, 15 and 27 recite that the contact lens composition contains a surfactant that can also cooperate in obtaining the highly soluble properties of the invention. The use of a surfactant is not shown in the prior art for this purpose. Claims 18 and 20 recite the thermal characteristics of the hot melt material of the invention. These claims recite that the material is a structural solid at temperatures of less than 30°F and a substantial melt at 140°F. Such complex mixtures do not have sharp melting points and cannot be characterized as such. However, such a material can be characterized by temperatures where the material is a structural solid and substantially a melt liquid. These claims define this temperature range and provide for material that has a melt profile that renders it suitable for handling by contact lens manufacturing personnel. The prior art compositions shown in Bunnelle et al. and other references have melt characteristics with substantially higher melting points rendering them substantially more difficult to handle. For these reasons, claim 18, as amended, is additionally allowable over this art.

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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Date

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